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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,065	01/29/2002	Dennis Chia-Bin Chen	53394.000559	3687

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT PAPER NUMBER

3761

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

6

Office Action Summary	Application No. 10/058,065	Applicant(s) CHEN ET AL.	
	Examiner Jacqueline F Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/1/05 have been fully considered but they are not persuasive.

Applicant argues Alemany discloses an absorbent pad having a structure comprised of wood pulp and SAP and that the absorbent properties that result from the various possible combinations of these raw materials are infinitely variable. Applicant further states given the teachings of Alemany with regard to the selection of those materials, one could experiment indefinitely without ever obtaining the present invention. Following this line of reasoning, the present invention discloses an absorbent pad comprising pulp and SAP, without any guidance as to the amount of either component needed to form the composition or the specific structure of the pad. It would require undue experimentation to arrive at the claimed test characteristics using the materials and disclose and structure disclosed.

Applicant further argues Alemany says nothing about the effect of the front pad absorbent capacity on the overall product. However, Alemany teaches at col. 12, line 54-59 that the acquisition zone (in the front pad) has a smaller concentration of SAP in the deposition area to enable this area to wick fluids to the storage area and thus improving the liquid acquisition rate. Additionally Alemany teaches the hydrophilic fibrous material and SAP may be disposed only in the deposition region (front pad) of the absorbent member and not in the remainder of the absorbent (col. 11, lines 42-46).

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., high AUL SAP in the front pad and high concentrations of lower AUL SAP in the front pad) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Finally, applicant argues there is not motivation to modify Alemany to provide the claimed front capacity, specifically that increasing the absorbent capacity at the insult point of Alemany would contradict the Alemany device's theory of operation. However, the features upon which applicant relies (i.e., increasing the absorbent capacity at the insult point) are not recited in the rejected claim(s). The claims are limited to the front pad having an absorptive capacity of at least about 32 grams. The front pad encompasses the insult point as well as the remainder of the front pad. The claims do not provide a limitation for increasing the absorbent capacity of the insult point. Therefore, even though Alemany teaches a lower basis weight and lower absorbent capacity acquisition zone, as long as the front pad as a whole is capable of having an absorbent capacity of 32 grams, the reference meets the claim limitations. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Specification

- a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification fails to adequately teach how to make and/or use the invention.

2. The disclosure gives a wide range of polymers as being suitable for providing the claimed performance characteristics. Additionally, specific test results are cited. No specific polymers or method of making the polymers are given. Without this disclosure, one of ordinary skill cannot practice the invention without undue experimentation.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. Claims 1, 15, 22, 26, and 29 fail to teach one of ordinary skill how to make and/or use the invention. The disclosure teaches a broad range of polymers and structures for the claimed invention, but fails to teach one of ordinary skill in the art the exact polymer needed or the exact method of forming the core composite material to provide the claimed test results. Without this disclosure, one of ordinary skill cannot practice the invention without undue experimentation because of the number of operational parameters in the process and uncertainty as to the mechanism for forming the core material.

Claim Rejections - 35 USC § 102/103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-29 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Alemany et al. USPN 4834735.

As to claims 1, 3-7, 15, 17-21, 22, 24, 26, and 28, Alemany discloses an absorbent core and by description, a method of designing an absorbent core comprising a composite and a wrapping material adjacent to the outer surface of the composite. The absorbent core is associated with an absorbent article, wherein the core further comprises a front pad **642** and a back pad **674** (Figures 6 and 7). It is the examiner's first position that pages 9, lines 12-24; page 10, lines 6-28; and page 21, line 25 through page 22, line 4 of the specification sets forth materials capable of providing the claimed absorptive capacity. Alemany teaches similar materials for the core (col. 7, line 58 through col. 9, line 28). Thus, Alemany inherently includes a core capable of providing the claimed absorptive capacity. "When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980)." In the present case, the reference has met the structural requirements of the claim.

Alemaný teaches the front pad comprises an insult point in the acquisition region. Any portion of the front pad 642 in the acquisition region can comprise a 2-inch diameter circle.

It is noted however, that Alemaný does not specifically disclose the absorbent core comprises a front pad that has an absorptive capacity of at least about 32 grams of an aqueous solution containing 1.0 weight. % sodium chloride absorbed after ten minutes of contact with the aqueous solution while under a restraining pressure of about 0.5 psi. However, Alemaný recognizes the size and concentration of materials of the absorbent core can be varied and this will affect the absorbent capacity in specific regions (col. 7, lines 57-67; col. 12, lines 41-59; col. 20, lines 6-68). Alemaný, therefore, recognizes the absorbent capacity is a result effective variable of the materials used to makeup the core. It is the examiner's second position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Alemaný with the claimed absorbent capacity, since discovering an optimum value of a result effective variable involves only routine skill in the art.

Alemaný teaches the shape, size, and positioning of the acquisition zone (insult point) is important with respect to the rapid acquisition of fluids and the point should be positioned with respect to the area of typical liquid deposition of the absorbent member (col. 15, lines 20-36).

Additionally, regarding claims 1, 3-7, 15, 17-21, and 26 the claimed test results are the outcome of performing the disclosed test procedures. The process of performing the tests are part of the method of producing the claimed article. "Even

though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In *re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). MPEP 2113.

As to claims 2, 16, 23, 25, and 27, Alemany discloses a circular insult point (Figures 1, 4, 5, and 6). Alemany does not specifically disclose a two-inch diameter circle. Alemany teaches the shape, size, and positioning of the acquisition zone (insult point) is important with respect to the rapid acquisition of fluids and the point should be positioned with respect to the area of typical liquid deposition of the absorbent member (col. 15, lines 20-36). It would have been obvious to one having ordinary skill in the art to determine the optimal size of the insult point for achieving maximum fluid acquisition. " In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device."

As to claims 8 and 10, see col. 20, lines 15-28.

As to claims 9 and 11-13, see col. 7, line 58 through col. 9, line 2; and col. 11, lines 21-37.

As to claim 14, see col. 18, lines 42-61.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

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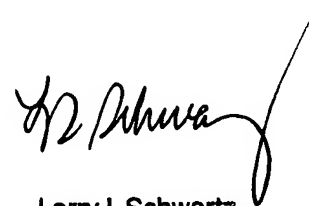
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacqueline F Stephens
Examiner
Art Unit 3761



May 16, 2005



Larry I. Schwartz
Supervisory Patent Examiner
Group 3700